REMARKS

This Amendment is made to the Office Action dated July 13, 2007. Claims 64 - 84 are pending in the present application. By this Amendment, claim 67 has been amended to depend from claim 66. The specification has been amended in response to the Examiner's objections addressed below. Reconsideration of the application is respectfully requested.

The Examiner objected to the drawings because Figure 17 contained reference numerals not mentioned in the specification. Applicants have amended the specification to include a description of the components disclosed in Figure 17. No new matter has been added to the specification. Applicants note that the amendments to the specification concerning Figure 17 can be found in the parent case, namely, U. S. Patent No. 6,390,993 (see column 6, lines 6-7 and column 11, lines 48-53).

The Examiner has objected to the specification based on the need to change the information concerning USSN 09/881,290 and to correct certain wording appearing on page 3. Applicants have amended the specification accordingly.

Claim 67 was objected to for being dependent upon claim 64, rather than, claim 66. Claim 67 has been amended to depend from claim 66.

Claim 64 was rejected under 35 U.S.C.§ 112, first paragraph, based on the Examiner's belief that claim 64 recites a single means limitation. Applicants respectfully disagree. Claim 64 is directed to an "elongated member" having "means for causing a substantial linear change in bending stiffness over a longitudinal length of the elongated member." The claim includes the recitation of a elongated member along with the "means for causing substantial linear change…" Therefore, claim 64 is not a single means limitation as stated by the Examiner. Applicants would agree with the Examiner if the component "elongated member" was not present in the claim. However, as written, claim 64 is not a single means claim. Applicants respectfully request the Examiner to withdraw this rejection.

Claim 69 also was rejected under 35 U.S.C.§ 112, first paragraph based on the Examiner's belief that claim 69 contains subject matter not described in the specification.

Applicants note that original claim 38 recites the subject matter presented in claim 69. Applicants submit that the subject matter of claim 69 is thus fully disclosed in the original specification since it appeared as one of the original claims. Applicants have amended the specification to incorporate the language appearing in original claim 38 and pending claim 69. Applicants submit that no new matter has been introduced into the application in view of this amendment to the specification. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

The Examiner has rejected claims 64-68, 70-74, 76-81, 83 and 84 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,991,602 to Amplatz et al. (the "Amplatz patent"). Applicants strongly disagree with the Examiner's position. Claims 64-68 and 70 are directed to an intracorporeal device comprising an elongated member having means for causing a substantially linear change in bending stiffness over the longitudinal length of the elongated member. Applicants submit that the Amplatz patent simply fails to disclose an elongated member having means for causing a substantially linear change in stiffness over the longitudinal length of the elongated member. Rather, the Amplatz patent only discloses a guidewire having tapered sections around reference numerals 12, 22 and 24 in Figure 2. The Amplatz patent is **completely devoid** of any disclosure that the tapered section of its guidewire has a means for causing a substantially linear change in bending stiffness over a longitudinal length of the elongated member. In fact, there is complete lack of disclosure in the Amplatz patent which describes any type of bending stiffness that would be associated with the tapered end of its guidewire. For this reason alone, the Amplatz patent fails to disclose the presently claimed invention recited in claims 64-68 and 70.

The Examiner's reliance on how one might interpret a non-linear curve is simply misplaced. The fact that a graph of a non-linear curve could be drawn in such a way that it appears that a short segment is somewhat linear does not prove that the Amplatz patent discloses a guidewire having a substantially linear change in stiffness over a longitudinal length of the guidewire. Applicants submit that the same short segment of the curve relied upon by the Examiner to support his position could also be redrawn using a

different scale for the graph which would clearly show that the short, allegedly linear segment relied upon by the Examiner is not linear at all. Therefore, proof of the disclosure of Applicants' presently claimed invention should not be dependent on one's interpretation of a graph, as the Examiner has done. Rather, the disclosure has to be found in the allegedly anticipatory reference. Simply put, the Amplatz patent fails to disclose Applicants' presently claimed invention. Applicants respectfully request the Examiner to withdraw the Amplatz patent as an anticipatory reference to claims 64-68 and 70.

The Examiner has rejected claims 71 and 78 on the basis that the Amplatz patent reads on claims 71 and 78 when the equations found in these claims are solved for L= 0. However, when L=0, there is no length to the elongate core member and therefore that portion of the guidewire does not exist. Therefore, the Examiner's position that the Amplatz patent reads on claims 71 and 78 when L=0 makes no sense since an elongated core member with a length of zero does not exist. Applicants respectfully request the Examiner to withdraw the Amplatz patent as an anticipatory reference to claims 71-74, 76-81, 83 and 84.

The Examiner has rejected claims 64, 66-72, 75-79 and 82-84 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,497,786 to Urick (the "Urick patent"). Applicants again strongly disagree with the Examiner's position. The failure of the Amplatz patent to disclose the structure of these claims, discussed in great detail above, applies equally to the Urick patent. For example, the Urick patent, like the Amplatz patent, is **completely devoid** of any disclosure that the tapered section of its guide wire has a means for causing a substantially linear change in bending stiffness over a longitudinal length of the elongated member. Again, there is complete lack of disclosure in the Urick patent which describes any type of bending stiffness that would be associated with the tapered end of its guidewire. For this reason alone, the Urick patent fails to disclose the presently claimed invention recited in claims 64 and 66-70.

The Examiner's reliance on how one might interpret a non-linear curve with respect to the Urick patent is again misplaced. The fact that a graph of a non-linear curve

could be drawn in such a way that a short segment appears somewhat linear does not prove that the Urick patent discloses a guidewire having a substantially linear change in stiffness over a longitudinal length of the guidewire. Applicants submit that the same short segment of the curve relied upon by the Examiner to support his position could also be redrawn using a different scale for the graph that would clearly show that this short, allegedly linear segment is not linear at all. Proof of the disclosure of Applicants' presently claimed invention in the prior art should not be dependent on how one might interpret a graph, as the Examiner has done. Rather, the disclosure has to be found in the allegedly anticipatory reference. Simply put, the Urick patent, like the Amplatz patent, fails to disclose Applicants' invention. Applicants respectfully request the Examiner to withdraw the Urick patent as an anticipatory reference to claims 64 and 66- 70.

The Examiner's rejection of claims 71, 72, 75-79 and 82-84 on the basis that the Urick patent reads on claims 71 and 78 when the equation is solved for L= 0 is again misplaced. In accordance with Applicants' arguments respecting the Amplatz patent, when the equation of claims 71 and 78 is solved for L=0, there is no length to core wire and therefore no guidewire exists using this assumption. Therefore, the Examiner's position that the Urick patent reads on claims 71 and 78 when L=0 makes no sense since a section of a guidewire with a zero length does not exist. Applicants respectfully request the Examiner to withdraw the Urick patent as an anticipatory reference to claims 71, 72, 75-79 and 82-84.

The Examiner has rejected the pending application under the judicially created doctrine of non-statutory double patenting. Applicants hereby submits a terminal disclaimer directed to U.S. Patent No. 6,666,829. Applicants note that the Examiner has also based this obviousness-type double patenting rejection on U.S. Patent No. 6,673,025 (the `025 patent) and co-pending application Serial No. 10/631,275. However, both the `025 patent and the co-pending application do not constitute prior art to the pending application. Therefore, the claims in the `025 patent and co-pending application do not "anticipate" any of the claims of the present application as stated by the Examiner.

Therefore, the terminal disclaimer presented herein has been made only with respect to U.S. Patent No. 6,666,829.

In view of the foregoing, it is respectively urged that all of the present claims of the application are patentable and in a condition for allowance. The undersigned attorney can be reached at (310) 824-5555 to facilitate prosecution of this application, if necessary.

In light of the above remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any fees payable in connection with this response to Deposit Account No. 06-2425.

Respectfully submitted,
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